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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,473	09/17/2003	Carey E. Garibay	BEAS-01454US7	4342
23910 7590 07/25/2008 FLIESLER MEYER LLP 650 CALIFORNIA STREET 14TH FLOOR SAN FRANCISCO, CA 94108				
EXAMINER AGWUMEZIE, CHARLES C				
ART UNIT 3685		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/664,473

**Applicant(s)**

GARIBAY ET AL.

**Examiner**

CHARLES C. AGWUMEZIE

**Art Unit**

3685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 April 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-129 is/are pending in the application.  
4a) Of the above claim(s) 19-66, and 68-119 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-18, 67-76 and 120-129 is/are rejected.  
7) ☐ Claim(s) 43 and 64 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date see continuation  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

09/17/03; 03/11/05; 05/26/06; 01/17/07; 08/06/07; 10/31/07; 02/27/08; 05/23/08; and 06/19/08

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 1, 2008 has been entered.

### **Acknowledgment**

2. Applicants' amendment filed on April 09, 2008 is acknowledged. Accordingly claims 1-9, 10-18, 67-76, and 120-129, remain pending.

### **Response to Arguments**

3. Applicant's arguments filed on April 4, 2008 have been fully considered but they are not persuasive.
4. With respect to **claims 1, 10, 67 and 120** as amended, Applicant argues that "the licenses are selected in the batch mode from a license search result page" and that this feature is not shown or made obvious by the cited prior art.
5. In response, Examiner respectfully disagrees and submits that Ross does disclose that "the licenses are selected in the batch mode from a license search result page" For example Ross made it clear that one or more licenses in a batch of licenses

can be enabled to create a software license. Accordingly Ross does disclose the claimed limitation. Furthermore Aldis discloses a license pack. A license pack contains one or more digital licenses. Arguably a license pack is equivalent to the multiple software licenses in a batch mode as disclosed by present invention. For these reasons claims 1, 10, 67 and 120 are not patentable over the references of record.

### ***Claim Objections***

6. **Claims 43 and 63**, are objected to because of the following informalities: Claims 43 and 63 depend from claims 39 and 53 respectively which are withdrawn from further consideration. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. **Claims 1-9 and 67-76**, are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

9. Based on Supreme Court precedent<sup>1</sup> and recent Federal Circuit decisions, § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different

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<sup>1</sup> *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

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state or thing.<sup>2</sup> If neither of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. § 101.

10. In this particular case, Claim 1-9 and 67-76 are neither (1) tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. Accordingly claims 1-9 and 67-76 are directed to non-statutory subject matter.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 1-8, 10-17, 67-76, and 120-129**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Aldis et al U.S. Patent Application Publication No. 2004/0039916 A1 in view of Ross et al U.S. patent No. 5,553,143 and further in view of Stupek Jr. et al U.S. Patent No. 5,960,189.

13. As per **claim 1, 10, 67, and 120**, Aldis et al discloses a method comprising:  
maintaining digital records of software licenses, the digital records indicating rights associated with software licenses (0005; 0015; 0121).

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<sup>2</sup> The Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972).

under the control of a software user, upgrading or downgrading the software version for multiple software licenses in a batch mode, an indication of the upgrade or downgrade being stored in the digital record (see abstract (see figs. 4 and 5; 0008; 0010; 0011; 0019; 0139; 0070; "license packs");

Aldis et al teaches that the digital license can be distributed in a license pack. A license pack contains one or more digital licenses. Arguably a license pack is equivalent to the multiple software licenses in a batch mode as disclosed by present invention (see figs. 4 and 5; 0008; 0010; 0011; 0019; 0139; 0070; "license packs").

14. What Aldis does not explicitly disclose is that the upgrade or downgrade is done in a batch mode and

wherein the upgrading or downgrading of the software licenses includes displaying a page that shows current licenses to the user and receiving from the user an indication of what current licenses are selected to upgrade or downgrade, as well as an indication to upgrade or downgrade the selected licenses in the batch mode, the upgrading and downgrading involves providing new license keys for the upgrade/downgrade version, as well as disabling the license keys for the old versions

wherein the licenses are selected in the batch mode from a license search result page (Aldis et al however teaches that the digital license can be distributed in a license pack. A license pack contains one or more digital licenses. Arguably a license pack is equivalent to the multiple software licenses in a batch mode as claimed by present invention).

15. Ross et al discloses a method comprising: under the control of a software user, upgrading or downgrading the software version for multiple software licenses in a batch mode, an indication of the upgrade or downgrade being stored in the digital record (see abstract; col. 1, line 65-col. 2, line 15, which discloses that one or more licenses in a batch of licenses can be enabled to create a software license; col. 30-35; col. 4, lines 25-35; ...a batch of licenses may be anchor or upgrade licenses...);

wherein the licenses are selected in the batch mode from a license search result page (see abstract; col. 1, line 65-col. 2, line 15, which discloses that one or more licenses in a batch of licenses can be enabled to create a software license)

16. Stupek Jr. et al discloses wherein the upgrading or downgrading of the software licenses includes displaying a page (window list box 51 is displayed to the user, fig. 6) that shows current licenses to the user (shows current version, fig. 9) and receiving from the user an indication of what current licenses are selected to upgrade or downgrade, as well as an indication to upgrade or downgrade the selected licenses in the batch mode, the upgrading and downgrading involves providing new license keys for the upgrade/downgrade version, as well as disabling the license keys for the old versions (see fig. 5; "can the user select this package for upgrade"; fig. 6, "list box displayed to the user"; see also figs. 9 and 10, installed version 2.30, newest version 2.40; col. 4, lines 45-55, which discloses "when the upgrade advisor 11 and/or user have selected the network resources 3 that need to be upgraded"; see col. 6, line 60-17, which discloses "package can be displayed to the user through a user interface"; col. 9, lines



15-40, which discloses ... display or report upgrade to the user including using color coded visual object...);

17. Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Aldis et al and incorporate the method wherein under the control of a software user, upgrading or downgrading the software version for multiple software licenses in a batch mode, an indication of the upgrade or downgrade being stored in the digital record and displaying a page as taught by Ross et al and Stupek Jr. et al respectively since the claimed invention is merely a combination of old and known elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary art would have recognized that the results of the combination were predictable.

18. As per claims 2, 11, 68, and 121, Aldis et al further discloses the method, wherein the upgrading or downgrading of rights is associated with the license key (0019; 0070).

19. As per claims 3, 12, 69, and 122, Aldis et al further discloses the method, wherein the digital record is accessed using a web application (see fig. 1; 0065; 0066 0147; "web browser or API").

20. As per claims 4, 13, 70, and 123, Aldis et al further discloses the method, wherein the web application uses role-based security (0005).

21. As per **claims 5, 14, 71, and 124**, Aldis et al further discloses the method, wherein digital records contain configuration information for the computer authorized to run the software (0010; 0072; "...hardware fingerprint of computer requesting activation code...").

22. As per **claims 6, 15, 72, and 125**, Aldis et al further discloses the method, wherein the digital records can be searched to find a specific digital record (0078; 0121; 0124; "...search and view licenses created...").

23. As per **claims 7, 16, 73, and 126**, Aldis et al further discloses the method, wherein the rights are associated with a license key (0019; 0070).

24. As per **claims 8, 17, 74, and 127**, Aldis et al further discloses the method, wherein configuration information for the computers running the software is stored in the digital record (0010; 0072).

25. As per **claims 76, and 129**, Aldis et al further discloses the method, wherein upgrading or downgrading of the version is done for multiple software licenses in a batch mode (0019; 0070; "license packs").

26. As per claim 128, Aldis et al further discloses the method, wherein the license version can also be upgraded (0103).

27. Claims 9, and 18, are rejected under 35 U.S.C. 103(a) as being unpatentable over Aldis et al U.S. Patent Application Publication No. 2004/0039916 A1 in view of Ross et al U.S. patent No. 5,553,143 and in view of Stupek Jr. et al U.S. Patent No. 5,960,189 as applied to claims 1, and 10, above, and further in view of Horstmann U.S. Patent No. 6,009,401.

28. As per claims 9, and 18, Aldis et al, Ross et al failed to explicitly disclose the method, wherein the license version is downgraded.

Horstmann discloses the method, wherein the license version is downgraded (fig. 1; col. 2, line 60-col. 3, line 15).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Aldis et al and incorporate the method, wherein the license version is downgraded as taught by Horstmann in order to ensure availability of various product versions and/or user satisfaction.

### ***Conclusion***

29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references cited to Biddle U.S. Patent Application

Publication No. 2002/0107809 and Birkholz et al U.S. Patent No. 7,055,149 are documents considered relevant to the claimed invention.

**Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles C. Agwumegie whose number is **(571) 272-6838**. The examiner can normally be reached on Monday – Friday 8:00 am – 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on **(571) 272 – 6709**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free). If you would like assistance from a USPTO

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Customer Service Representative or access to the automated information system, call  
800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Charlie C Agwumezie/  
Primary Examiner, Art Unit 3685  
July 23, 2008